

REMARKS

Applicant has carefully reviewed the Application in light of the Office Action mailed October 6, 2004. At the time of the Office Action, Claims 1-30 were pending in the Application. Applicant amends Claims 1, 3, 5, 10, 14, 20, 23, and 28 and cancels Claims 4, 16, 22, and 29 without prejudice or disclaimer. The amendments and cancellations to these claims are not the result of any prior art reference and, thus, do not narrow the scope of any of the claims. Furthermore, the amendments are not related to patentability issues and only further clarify subject matter already present. All of Applicant's amendments have only been done in order to advance prosecution in this case. Applicant respectfully requests reconsideration of the pending claims and favorable action in this case.

In The Specification

The Examiner objects to the specification because it fails to refer to "Step 186" of Figure 11. Applicant apologizes for this minor oversight and has made a minor amendment to the Specification to correct this error. No new matter was entered in the Application as a result of the amendment.

In The Drawings

The Examiner objects to the drawings because there are some minor errors present. Applicant apologizes for these clerical mistakes. A corrected FIGURE 1 formal drawing for the Application has been appended to this Response. Applicant submits that the corrected formal drawing does not add any new matter to the Application and is in full compliance with 37 U.S.C. §1.81, §1.83, and §1.84.

Section 112 Rejection

The Examiner rejects Claims 3-5 and 22-23 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter. Applicant has made a series of minor amendments to correct these errors and to address the Examiner's concern.

Section 102 Rejection

The Examiner rejects Claims 1-6, 10-11, 14-25, and 28-30 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,052,718 issued to Gifford (hereinafter "*Gifford*"). This rejection is respectfully traversed for the following reasons.

Independent Claim 1, as amended, recites a method for providing a distributed service in a network that includes: "receiving lease constraints associated with a request to use the distributed service, wherein the lease constraints include a percentage of the distributed service available and an amount of resources required to execute the percentage of the distributed service..." By contrast, *Gifford* discloses a replica system, but fails to offers any subject matter relevant to the above-identified limitations. This is because the architecture of *Gifford* operates in a different manner and, thus, does not account for lease constraints, which include a percentage of the distributed service available and an amount of resources required to execute the percentage of the distributed service.

In the Office Action, the Examiner failed to cite any portion of *Gifford* that offers such a disclosure or that is even relevant for such a teaching. Accordingly, Independent Claim 1 is patentable over *Gifford* for at least this reason. Additionally, Independent Claims 10, 14, 20 and 28 include a similar limitation and, thus, are also allowable over *Gifford* for similar reasons. In addition, the corresponding dependent claims associated with these Independent Claims are also patentable over *Gifford* for analogous reasons.

Section 103 Rejections

The Examiner rejects Claims 7-9, 12-13, and 26-27 under 35 U.S.C. §103(a) as being unpatentable over *Gifford* in view of U.S. Patent No. 5,341,477 issued to Pitkin et al. (hereinafter "*Pitkin*"). This rejection is respectfully traversed for the following reasons.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation; either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior reference (or references when combined) must teach or suggest all of the

claim limitations.<sup>1</sup> It is respectfully submitted that these rejected Claims are patentable over the art of record based on at least the third criterion of obviousness: none of the references alone or in combination teach, suggest, or disclose each and every claim limitation.

The Independent Claims have been shown to be allowable in the §102 analysis above, as they are distinguishable over *Gifford*. Furthermore, these secondary references do not provide any disclosure that is combinable with *Gifford* that could inhibit the patentability of the pending claims. Thus, the Examiner has failed to satisfy each of the elements of non-obviousness, which are required to support a proper §103 analysis according to M.P.E.P. §2143.

However, for purposes of redundancy and to unquestionably demonstrate the allowability of the pending claims, Applicant proffers this additional analysis for the convenience of the Examiner. As an initial matter, Applicant wishes to note that even if these elements of Independent Claim 1 were disclosed in the cited references, which they are not, the proposed *Gifford-Pitkin* combination is still improper because the Examiner has not shown the required suggestion or motivation in *Gifford* or in *Pitkin*, or in the knowledge generally available to one of ordinary skill in the art at the time of the invention to combine these references. The mere fact that references *can* be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.<sup>2</sup> Thus, the mere fact that the teachings of one reference would improve the teachings of another reference, as the Examiner asserts, does not provide the required suggestion to combine. The U.S. Court of Appeals for the Federal Circuit has held that the fact that the prior art may be modified does not make the modification obvious unless the prior art suggests the desirability of the modification.<sup>3</sup> Nothing in *Gifford* or in *Pitkin* suggests or motivates the proposed combination, nor has the Examiner provided evidence that suggests or motivates the proposed combination.<sup>4</sup> Speculation in hindsight that “it would have been obvious” to make the proposed combination because the proposed combination

---

<sup>1</sup> See M.P.E.P. §2142-43.

<sup>2</sup> M.P.E.P. §2143.01 (emphasis in original).

<sup>3</sup> In *re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992).

<sup>4</sup> If “common knowledge” or “well known” art is being relied on to combine the references, Applicant respectfully request that a reference be provided in support of this position pursuant to M.P.E.P. §2144.03. If personal knowledge is being relied on to supply the required motivation or suggestion to combine, Applicant respectfully requests that an affidavit supporting such facts be provided pursuant to M.P.E.P. §2144.03.

the proposed combination because the proposed combination would be helpful is insufficient under M.P.E.P.<sup>5</sup> guidelines and governing Federal Circuit case law.<sup>6</sup> The M.P.E.P. consistently confirms that this approach is improper and, thus, it should not be used here.<sup>7</sup>

In the context of the second criterion of non-obviousness, the Examiner has also failed to show a reasonable expectation of success for the proposed combinations. Therefore, Applicant respectfully submits that the Examiner has also failed to establish the second criteria for a prima facie case of obviousness. Accordingly, these rejected claims are also allowable over the references cited by the Examiner based on, at least, this reason.

Therefore, all of the pending claims have been shown to be allowable over the references of record. Notice to this effect is respectfully requested in the form of a full allowance of the pending claims.

---

<sup>5</sup> See M.P.E.P. §2145 X.C. ("The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.").

<sup>6</sup> For example, in *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999), the Federal Circuit reversed a finding of obviousness by the Board of Patent Appeals and Interferences, explaining that evidence of a suggestion, teaching, or motivation to combine is essential to avoid impermissible hindsight reconstruction of an applicant's invention:

Our case law makes clear that the best defense against the subtle but powerful attraction of hindsight obviousness analysis is *rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references*. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.

175 F.3d at 999 (quoting *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983)) (emphasis added) (citations omitted). See also *In Re Jones*, 958 F.2d 347 ("Conspicuously missing from this record is any evidence, other than the PTO's speculation (if that can be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modification of the prior art salts necessary to arrive at [the claimed invention].").

<sup>7</sup> See M.P.E.P. §2145.

ATTORNEY DOCKET NO.  
062891.0567

PATENT APPLICATION  
09/864,749

15


CONCLUSION

Applicant has now made an earnest attempt to place this case in condition for immediate allowance. For the foregoing reasons and for all other reasons clear and apparent, Applicant respectfully requests reconsideration and allowance of the pending claims.

Applicant believes no fee is due. However, if this is not correct, the Commissioner is hereby authorized to charge any additional fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts, L.L.P.

If there are matters that can be discussed by telephone to advance prosecution of this application, Applicant invites the Examiner to contact Thomas Frame at 214.953.6675.

Respectfully submitted,  
BAKER BOTTS L.L.P.  
Attorneys for Applicant

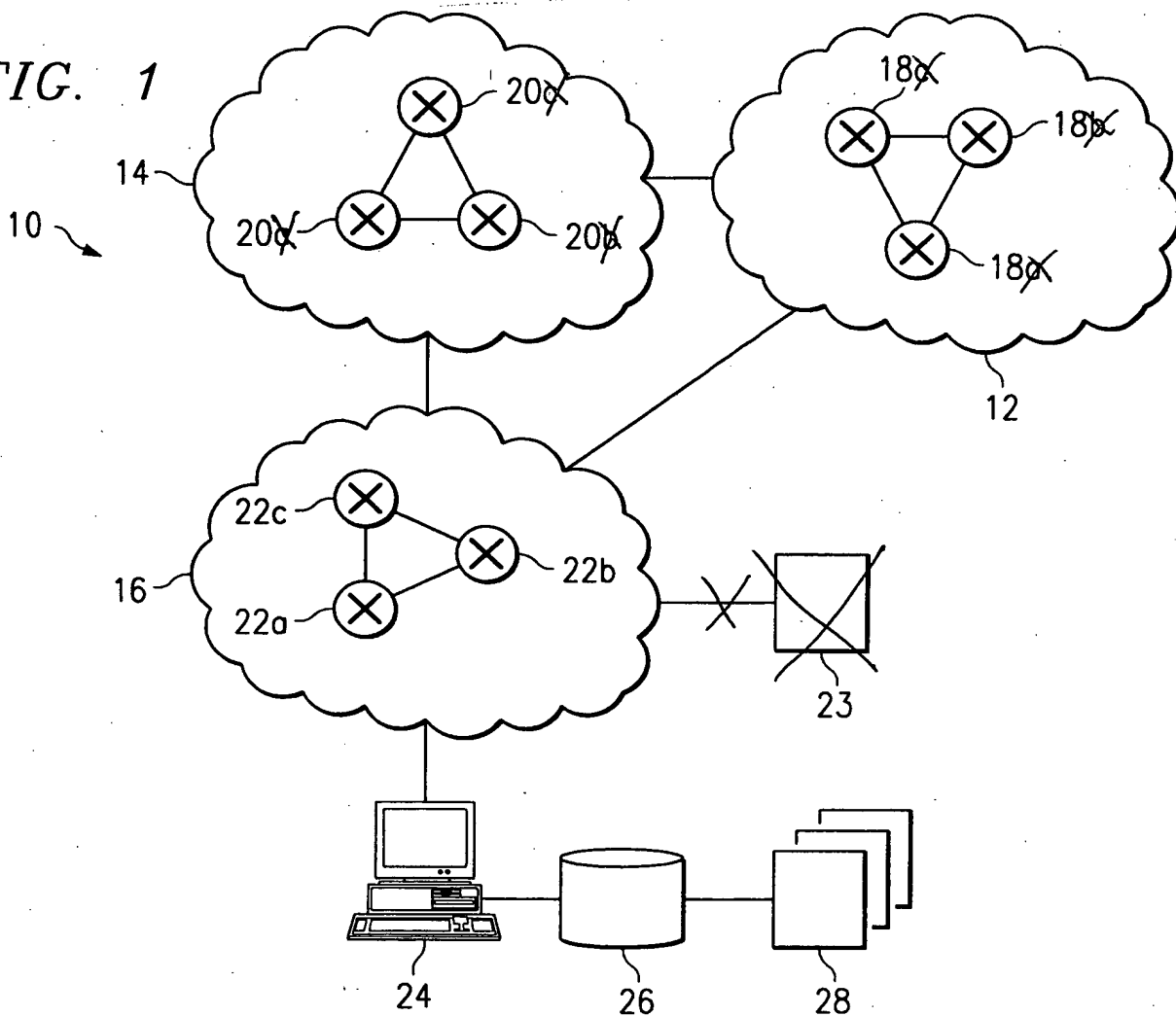
  
\_\_\_\_\_  
Thomas Frame  
Reg. No. 47,232

Date: October 21, 2004

Customer No. **05073**

OIP E 356  
OCT 21 2004  
PATENT & TRADEMARK OFFICE

FIG. 1



18

FIG. 2

